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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,298

10/16/2003

Donagh O'Shaughnessy

PI369 US

9179

28390

7590

07/22/2005

MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

OSELE, MARK A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,298

Applicant(s)

O'SHAUGHNESSY ET AL.

Examiner

Mark A. Osele

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller, Jr. Mueller, Jr. shows the method of welding two overlapping portions of polymeric material comprising a catheter shaft and a balloon neck to create a joint and applying a tensile force to the joint region to elongate the joint region, thus thinning the joint region (column 2, lines 42-64, Figs. 3, 4).
3. Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Vannan et al. Vannan et al. shows the method of welding two overlapping portions of polymeric material to create a joint and applying a tensile force to the joint region to elongate the joint region, thus thinning the joint region (column 6, lines 29-42, Figs. 5, 6). Regarding claim 6, the tensile force appears to be applied to a cold joint.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over NL 6814117. NL 6814117 shows the method of welding two overlapping portions of polymeric material to create a joint and applying a tensile force to the joint region (English Abstract--XP002256166). Although the abstract is silent as to the joint region being thinned by the tensile force, the abstract and a preliminary translation of page 3, lines 15-29 teach the films to be stretched. Stretched films will inherently be thinned.

Regarding claims 7 and 8, the joint is heated by the application of hot air from element 6.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over NL 6814117. As shown in paragraph 5 above, NL 6814117 shows the claimed limitations except for the amount of tensile force applied. Absent the showing of unexpected results, the amount of force required to achieve the desired elongation would be determined by one of ordinary skill in the art as a matter of routine optimization.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller, Jr. in view of NL 6814117. As shown in paragraph 2 above, Mueller, Jr. shows the claimed limitations except for the tensile force applied between two clamped regions. NL 6814117 shows the elastomeric material clamped on both sides of the joint region for stretching (Fig. 1). It would have been obvious to one of ordinary skill in the art at

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the time the invention was made to clamp both sides of the joint region of Mueller, Jr. because NL 6814117 shows the clamping to hold the overlapped layers together and because the clamps provide attaching members for the stretching means.

Response to Arguments

8. Applicant's arguments filed April 25, 2005 have been fully considered but they are not persuasive. Applicant first argues that Mueller, Jr. does not show thinning the joint section after bonding. As shown in paragraph 2 above, Mueller, Jr. shows the method steps of heating, thinning, and welding the joint section. Although the order of the steps in Mueller, Jr. may not be identical to the order of the instant invention, the order of steps are not limitations in a method claim unless specifically stated to provide a limitation with language such as, "The method with the steps in the following order..." The instant claims do provide any specifically stated limitation. In addition, Mueller, Jr. shows that heating is used to thin and weld the layers, thereby meeting the limitations of claim 7.

Regarding the arguments directed to the Vannan et al. reference, heat without adhesive is also known for splicing rubber strips (Divincenzo et al., abstract; Majumdar et al., paragraphs 0001, 002, 0004). In view of the fact that Vannan et al. teaches that the layers of the rubber strips are joined while still hot (column 2, lines 22-31) and does not disclose the need for an adhesive, it is believed that the joining of the strips of Vannan et al. is done by welding.

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Finally, applicant argues that the NL Patent 6814117 does not show thinning in the drawing, applicant is correct that the cross hatching lines are parallel. The disclosure of NL 6814117 does teach, however, that films are stretched while hot (preliminary translation of page 3, lines 15-29). This along with the abstract shows the result of thinning the films because stretching inherently thins films.

Response to Amendment

9. The amendment to the specification is acceptable. The amendment to claim 5 overcomes the rejection under 35 U.S.C. 112.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK A. OSELE
PRIMARY EXAMINER
July 20, 2005